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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/071,938

02/07/2002

Robert John Mulligan

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09/13/2006

EXAMINER

NGUYEN, QUYNH H

MOTOROLA INC

600 NORTH US HIGHWAY 45

ROOM AS437

LIBERTYVILLE, IL 60048-5343

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,938

Applicant(s)

MULLIGAN ET AL.

Examiner

Quynh H. Nguyen

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on remarks filed 7/7/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-34 and 40-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-34 and 40-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 1/26/06 has been entered. Claims 26, 28-29, 31-34, and 40-48 have been amended. No claims have been cancelled. No claims have been added. Claims 26-34 and 40-50 are still pending in this application, with claims 26, 29, 32, 34, and 40 being independent.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the at least one of non-thermal, non-visual sensation feature(s) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

CLAIMS

112 First Paragraph Rejection

4. Applicant amended claims 26, 29, 32, 34, and 40 to recite "at least one non-thermal, non-visual sensation", the 112 first paragraph rejection is maintained for the case "at least one non-visual sensation".

Claims 26-34, 40-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See comments below.

Claims 26-34, 40-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claims 26, 29, 32, 34 and 40, they all recited "non-visual sensation". This is questionable and contradicting the original disclosure which stated that it has "visual" effects in pages 2, 13-15 of the original disclosure. Therefore, it is considered as unenabling and possibly a new matter.

Art Rejection

5. Claims 26-34, 40-50, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Lehtiniemi et al. (US 6466299).

Regarding claim 26, Lehtiniemi shows a housing (fig. 1) comprising:

An outer surface (C) which includes a sensory producing substance (A1-A4) producing at one non-thermal, "*non-visual*" (see also 112 rejection above) sensation responsive to at least one stimulus (col. 1, lines 58-67).

Regarding claim 29, Lehtiniemi shows a housing (fig. 1) comprising:

An outer surface (C) including at least one shape element (see A1-A4) which includes a sensory producing substance (A1-A4) that produces at one non-thermal, "*non-visual*" sensation responsive to at least one stimulus (col. 1, lines 58-67).

Regarding claim 32, Lehtiniemi shows a housing (fig. 1) comprising:

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An outer surface (C) including at least one shape element (see A1-A4) that includes a sensory producing substance (A1-A4) that produces at one non-thermal, "*non-visual*" sensation responsive to at least one stimulus generated by a plurality of internal components (col. 1, lines 58-67).

Regarding claim 34, Lehtiniemi shows a housing (fig. 1) comprising:

An outer surface (C) which includes a sensory producing substance (A1-A4) that produces at least one adjustably, non-thermal, "*non-visual*" sensation responsive to at least one stimulus (col. 1, lines 58-67, col. 4, lines 20-58).

Regarding claim 40, Lehtiniemi shows a housing (fig. 1) comprising:

An outer surface (C) including at least one shape element (see A1-A4) which includes a sensory producing substance (A1-A4) that produces at least one non-thermal, "*non-visual*" sensation responsive to one or more operation of a plurality of internal components (col. 1, lines 58-67, col. 4, lines 20-58).

Regarding claims 27-28, 30-31, 33, 41-50, Lehtiniemi shows:

The housing (fig. 1);

The sensory producing substance is a combination of one or more substances selected from a group comprising a thermal producing substance, a vibration producing substance, and a haptic producing substance (col. 1, lines 58-67);

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The sensory producing substance causes the housing to provide to a user one or more sensations selected from a group comprising heat, pressure, and texture (col. 1, lines 58-67, col. 2, lines 3-14);

The stimulus is a combination of one or more stimuli selected from a group consisting of an acoustic, a thermal, an electrical, an electromagnetic, an olfactory, and a mechanical stimulus (col. 1, lines 58-67);

The one or more operations is selected from a group comprising a light from a keypad, light from a display, a vibration from an alerting mechanism, an audible alert from a speaker (col.1, lines 66-67, col. 4, lines 39-46, col. 8, lines 16-19).

ARGUMENT

6. In response to the remarks filed on 01/26/06, applicant mainly argues about "non-visual" sensation. This issue has been addressed above in the 112 rejection, see comments above. Since the 112 rejection maintained, the art rejection is also maintained.

7. Applicant's arguments with respect to claims 26-34 and 40-50 have been fully considered but are not persuasive.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh H. Nguyen whose telephone number is 571-272-7489. The examiner can normally be reached on Mon.-Thu. from 6:10 to 5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan, can be reached on 571-272-7493. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quynh H. Nguyen

September 15, 2006


WING CHAN
SUPERVISORY PATENT EXAMINER